

Application Serial No.: 10/659,246
Amdt. dated August 4, 2006
Reply to Final Office Action of March 7, 2006

REMARKS/ARGUMENTS

The Final Office Action dated March 7, 2006 and the references cited therein have been carefully considered. In response to the Office Action, Applicants have amended Claims 40, 46, 69, 78 and 88 which, when considered with the remarks set forth below, are deemed to place the case in condition for allowance. As a result of the present Amendment, Claims 40-88 remain in the case for continued prosecution.

Allowable Subject Matter

Claim 46 has been deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicants have rewritten Claim 46 in independent form. Accordingly, it is believed that Claim 46 is now in condition for allowance.

Claim Rejections - 35 USC §103

Claims 40-43, 50, 52-58, 63-71, 73-82, 85 and 87 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication No. WO 97/20315 to Heiligers et al. in view of U.S. Patent No. 5,868,986 to Foulkes and U.S. Patent No. 6,255,948 to Wolpert et al. Claims 44, 45, 47-49, 59-62 and 82-84 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiligers et al. in view of Foulkes and Wolpert et al. and further in view of U.S. Patent No. 4,639,341 to Hanamoto et al. Claims 51, 72 and 86 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiligers et al. in view of Foulkes, Wolpert et al. and further in view of U.S. Patent No. 5,815,292 to Walters and U.S. Patent No. 5,189,531 to Palmer et al. Finally, new Claim 88 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiligers in view of Foulkes and Wolpert et al.

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Independent Claims 40, 69 and 78

In response, Applicants have amended independent Claims 40, 69 and 78 to limit the storage device to one for a compact disc (CD) or a digital video disc (DVD) and to further define the authentication means as comprising authentication information unique to the individual CD or DVD to be stored in the storage device. It is respectfully submitted that none of the cited prior art references, taken alone or combined, teaches or suggests a storage device having an authentication means with authentication information unique to the individual CD or DVD to be stored in the storage device, as defined in amended Claims 40, 69 and 78.

One of the inventive features of the present invention is to be found in the fact that a CD/DVD storage box is used as an authentication means for the individual CD/DVD stored therein, by providing authentication means on or, preferably, incorporated in the storage box. It is not an object of the present invention to authenticate a storage box as such but to establish an authentication link between the storage box and the enclosed CD/DVD. None of the prior art references discloses such an authentication link.

In particular, while Heiligers discloses a CD storage box, Foulkes discloses in-mold labeling and Wolpert discloses integrally formed security devices, none of these references discloses incorporating into a storage box authentication information which is unique to the individual CD or DVD stored in the box. More specifically, Heiligers does not disclose nor suggest use of in-mold labeling and Foulkes does not disclose or suggest using in-mold labeling for CD or DVD boxes, nor does it disclose or suggest using in-mold labeling as a means of authentication of a product, let alone for establishing an authentication link between a storage box for a CD/DVD and the specific CD/DVD stored therein. Therefore, a skilled person would not combine these two documents.

Furthermore, although Wolpert describes a security device having multiple security features, this reference only discloses or suggests incorporating such security device directly into the product to be authenticated, such as banknotes, concert tickets or the like. Moreover, while Wolpert mentions utilizing the security device in "packaging means," there is no

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teaching or suggestion of using such in or on a storage box in order to make an authentication link between the storage box and a product to be stored therein, especially not a CD/DVD storage box and a CD/DVD to be stored therein.

Should a person skilled in the art be tempted to combine Wolpert with Heiligers, (which he would not for the reason that neither one of these documents gives any incentive or hint to do so) such skilled person would be inclined to use the authentication means according to Wolpert on the CD/DVD itself rather than in or on the storage box, since the CD/DVD would be the "merchandise" of relevant value. Such skilled person would not realize that the storage box itself should be provided with such authentication means for establishing an authentication link between said storage box and said CD/DVD.

In this respect, it should be noted that, in the prior art, the conventional method for labeling storage boxes or CD's/DVD's involves using tags, transponders, electronic labels or the like, which are anti-theft means and set off an alarm in, for example, a store and which are not in way linked to the actual product but are linked to the specific store and the installed anti-theft means. These are binary systems. If it is not demagnetized or otherwise deactivated, it will set off the alarm, no more and no less.

Thus, prior art cases for CD/DVDs are "universal" products, which are all identical, and are independent from the product to be stored therein. No indication whatsoever can be found in the prior art to provide a product-unique authentication means in the box in order to establish an individual authentication link between the box and the CD/DVD to be stored therein. Accordingly, it is respectfully submitted that independent Claims 40, 69 and 78, and the claims that depend therefrom, patentably distinguish over the prior art.

Independent Claim 88

Independent Claim 88 has been amended to include the same limitations as independent Claims 40, 69 and 78. Accordingly, it is respectfully submitted that independent Claim 88 is patentable for the same reasons as set forth above.

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Claim 88, however, includes further limitations relating to the steps of providing a transfer ink directly on a mold surface with a printer head. The Examiner states that Wolpert discloses providing graphic indicia printed in half tone with tiny dots and using multiple print stations, and that would lead a person skilled in the art towards the present invention as defined in Claim 88.

However, Wolpert only discloses printing on labels, layers of labels and the like and does not provide any indication whatsoever for printing directly onto a mold surface for transferring an image when later on a product is injection molded in a mold having said surface. Thus, contrary to the Examiner's assertion, Wolpert does not disclose printing on a mold surface at all. For this additional reason, Claim 88 should be allowable.

Dependent Claims 53, 54 and 66

It is further submitted that dependent Claims 53, 54 and 66 include additional limitations not found in the prior art. Therefore, these claims should also be allowable based on these additional limitations.

The Examiner states that, from the combination of Heiligers, Wolpert and Foulkes, it would have been obvious to provide printing on both sides of a label for injection molding. However, none of the prior art references, taken alone or combined, suggest such feature. In particular, Foulkes describes an in-mold injection molded label that is printed on one side only. A person skilled in the art would find no incentive in Foulkes to provide injection molding on both sides, since the label disclosed by Foulkes is provided on a plastic product having a relatively high chalk content, which would lead to an opaque plastic material. Therefore, providing printing on both sides would be illogical since it would never be visible from at least one of said sides. Therefore, even if a person skilled in the art were to combine the three documents as suggested by the Examiner, he would find no incentive to provide printing on both sides of a label, especially not such that it would be visible from both sides by providing an at least partly transparent carrier.

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It is respectfully submitted that it is not well-known in the prior art to present printing on both sides of a label or injection molding which would be visible on both sides of a product. On the contrary, as discussed above, boxes are normally opaque when injection molded and therefore providing printing on both sides would be useless. In the jewel case CD boxes, one cover may be transparent but these are, up to now, never injection molded for obvious reasons. Therefore, again these do not disclose nor render obvious printing on both sides of an injection molding label, as defined in Claims 53, 54 and 66.

Dependent Claims 63 and 64

It is further submitted that dependent Claims 63 and 64 include additional limitations not found in the prior art. Therefore, these claims should also be allowable for these additional reasons.

With respect to Claims 63 and 64, the Examiner refers to the combination of Heiligers, Wolpert and Foulkes and states that using a melting index of at least 30 or 50 would be obvious. However, no indication whatsoever can be found in any of these references of providing a plastic for injection molding having a melting index in the claimed range. Accordingly, Claims 63 and 64 should also be allowable.

Dependent Claims 44, 45, 47-49, 59-62 and 82-84

With respect to Claims 44, 45, 47-49, 59-62 and 82-84 the Examiner has rejected these claims based on the combination of Heiligers, Foulkes and Wolpert, and further in view of Hanamoto. Hanamoto discloses an apparatus for injection molding, providing a means for providing a pattern on a label directly, prior to forming a product. In this document the apparatus is provided for a type of vacuum forming of the "label," after which a molten plastic material can be forced against the "label" in a mold. The pattern sheet has previously been provided with a series of patterns, at a repeating distance, placed such that at any one time, one pattern can be brought in front of the female mold and an adjacent, next pattern is provided next to said mold. The pattern sheet is then heated, such that it can be forced into

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the mold by, for example, pressurized air, whereas register marks are spaced apart by the relevant predetermined distance in order to be able to easily locate said pattern over said female mold.

It is respectfully submitted that Hanamoto does not provide an effective method to molding articles by injection molding while simultaneously imprinting or transferring patterns on a continuous sheet on or to the molded articles, as defined in Claims 44, 45, 47-49, 59-62 and 82-84. Indeed, Hanamoto only discloses use of pre-printed patterns on such a sheet. Therefore, even if the combination of the cited three documents with Hanamoto would be obvious, it would still not lead a person skilled in the art to the present invention.

Moreover, stretching of the label prior to positioning is not disclosed in Hanamoto. In Hanamoto the label is plastically deformed during placing, which is different from the feature of the present invention. Accordingly, Claims 44, 45, 47-49, 59-62 and 82-84 should also be allowable for these additional reasons.

Dependent Claims 51, 72 and 86

The Examiner has rejected Claims 51, 72 and 86 based on still further references, namely a further combination of Walters and Palmer. These additional references are relied upon for their disclosure of holograms.

However, while Walters discloses holograms as commonly used authentication devices, this reference describes providing plastic layers by embossed or surface casts with contrasting surface relief diffraction patterns. Moreover, no disclosure is given of injection molding products with such embossing.

Palmer discloses the use of holograms on digital compact audio discs or video discs. Again, this would lead a person skilled in the art towards authentication of the CD or DVD itself, as opposed to the storage box and would certainly not motivate one skilled in the art to establish an authentication link between the storage box and the DVD/CD. On the contrary, these documents would lead a person skilled in the art to the idea that providing

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authentication means on the CD/DVD itself would be sufficient for authentication purposes.
Therefore, it would lead a person skilled in the art away from the present invention.

Conclusion

In view of the foregoing amendment and remarks, favorable consideration and allowance of the application with Claims 40-88 are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicants' attorney at the telephone number listed below.

Respectfully submitted,



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